

REMARKS

Claims 65-78 and 119-130 are currently pending, of which claims 65 and 119 are in independent form. Claims 65 and 76 are amended by the present response.

Claims 97-107 have been cancelled without prejudice, waiver, limitation or estoppel. New claims 119-130 have been added.

No new matter is added hereby.

Favorable reconsideration of the present patent application as currently constituted is respectfully requested.

Regarding the Double Patenting Rejection

Claims 65 and 97 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 10 and 16 of U.S. Patent No. 7,509,376 (the '376 patent).

Without acquiescing in the characterization of the claims of the present patent application or of the allegedly conflicting claims of the '376 patent, Applicant submits that the outstanding double patenting rejection with respect to claim 97 and its dependent claims is now moot by virtue of cancellation of claims 97-107. Additionally, it is respectfully submitted that none of the allegedly conflicting claims 1, 7, 10 and 16 of the '376

patent recites the features relating to receiving from the mobile data communication device a reply e-mail message; and facilitating transmission of the reply e-mail message to the sender, wherein the first address is configured as the reply e-mail message's originating address, as currently set forth in base claim 65. For the reasons set forth below, it is believed that these features render base claim 65 and its dependent claims patentably distinguishable over the allegedly conflicting claims of the '376 patent. Applicant therefore submits that the outstanding double patenting rejections have been overcome or otherwise rendered moot.

Regarding the Claim Rejections - 35 U.S.C. §112

Claims 97-107 stand rejected under 35 U.S.C. §112, second paragraph. Without acquiescing in the characterization of claims 97-107 provided in the pending Office Action, Applicant has cancelled claims 97-107. The outstanding rejections under 35 U.S.C. §112 are therefore moot.

Regarding the Claim Rejections - 35 U.S.C. §103

In the pending Office Action, claims 65, 67-70, 89, 97 and 99 stand rejected under 35 U.S.C. §103(a) as being unpatentable

over U.S. Patent No. 5,958,006 to Eggleston et al. (hereinafter the *Eggleston* reference) in view of U.S. Patent No. 5,826,023 to Hall et al. (hereinafter the *Hall* reference).

Additionally, claims 71-73 and 100-102 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of the *Eggleston* and *Hall* references in view of Official Notice that "word processing files, audio files, and video files were all old and well known types of email attachments at the time the invention was made, and that word processing type files could be processed (displayed) by mobile devices while video files could not, due to limitations on processing capabilities at the time."

Finally, claims 66, 74-78, 98, and 103-107 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Eggleston*, *Hall* and Official Notice in view of U.S. Patent No. 5,964,833 to Kikinis (hereinafter the *Kikinis* reference).

Without acquiescing in the characterization of the rejected claims and/or of the cited art provided in the Office Action, Applicant respectfully submits that the foregoing §103(a) rejections have been overcome or otherwise rendered moot by way of the present response. As currently amended, base claim 65 recites the features relating to, *inter alia*, receiving from the

mobile data communication device a reply e-mail message and facilitating transmission of the reply e-mail message to the sender, wherein the first address is configured as the reply e-mail message's originating address.

Relative to these newly added features, Applicant wishes to bring to the attention of the Office the recently-decided interference between Patent No. 6,219,694 (commonly owned by the assignee of the instant patent application) and Application No. 09/095,325 (real party in interest being Motorola, Inc.), which was previously referred to by Applicant in a related patent application (Appl. No. 09/782,107; Attorney Docket No.: 1400-1072D1; Client Ref. No.: 10072-US-DIV1) that is also before the Examiner of this instant application. This interference is styled Lazaridis v. Eggleston, Patent Interference 105,700, whose record may be found at <https://acts.uspto.gov/ifiling/> (by clicking the blue "Interferences" bar to enter the BPAI portal and entering the interference number "105700"). The single count of the interference is claim 60 of the '325 application or claim 28 of the '694 patent. These claims are reproduced below:

60. (Eggleston '325 application) A method for forwarding messages generated at a mobile client by a message sender destined for a message recipient, comprising the steps of:

receiving a message, generated at the mobile client by the message sender destined for the message recipient, at a forwarding component associated with a host system, wherein messages generated at the host system by the message sender use a first address;

configuring the received message such that the received message appears to the message recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile client or host system appear to originate at the message sender's first address; and

forwarding the configured received message to the message recipient.

28. (Lazaridis '694 patent) A method for redirecting messages generated at a mobile data communication device by a message sender destined for a message recipient, comprising the steps of:

receiving a message, generated at the mobile data communications device by the message sender destined for the message recipient, at a redirector component associated with a host system, wherein messages generated at the host system by the message sender use a first address;

configuring address information of the received message such that the received message uses the message sender's first address as the address originating the message, wherein messages generated at either the mobile data communications device or host system share the message sender's first address; and

redirecting the configured received message to the message recipient.

Applicant respectfully submits that the *Eggleston* reference applied in the present Office Action is substantively identical

to the disclosure of the involved Application No. 09/095,325 and that the May 2, 2011 Decision of the Board of Patent Appeals and Interferences in *Lazaridis v. Eggleston*, Patent Interference 105,700 (Administrative Patent Judges: Jameson Lee, Richard Torczon and Sally C. Medley) supports Applicant's position that *Eggleston* neither explicitly nor inherently discloses at least the features of configuring a user's first address as the reply e-mail message's originating address. The May 2, 2011 Decision and Judgment may be found at USPTO website identified above, which are also being submitted by Applicant in a supplemental Information Disclosure Statement. The May 2, 2011 Decision specifically addressed -- and rejected -- the BPAI's prior interpretation of identical disclosure in an *ex parte* appeal (Appeal No. 2003-2074) of the involved application (Application No. 09/095,325) and concluded that the *Eggleston* disclosure was entirely lacking in respect of the foregoing features.

Based on the foregoing discussion, Applicant respectfully submits that the applied *Eggleston* reference is critically deficient with respect to base claim 65 as currently constituted as well as the newly added base claim 119. Further, this deficiency is not cured by the secondary art, i.e., the *Hall* and *Kikinis* references, relied upon in the present Office Action.

All pending claims of the present application are therefore believed to be in condition for allowance.

Reservation of Rights

Notwithstanding the foregoing, Applicant reserves all rights not exercised in connection with this response, such as, e.g., the right to challenge or rebut any tacit or explicit characterization of any reference or of the present claims, the right to challenge any Official Notice(s) taken, the right to challenge or rebut any asserted factual or legal basis of any of the rejections of the present Office Action, or the right to swear behind any cited reference such as provided under 37 C.F.R. §1.131 or otherwise.

Fee Statement

Compared to the highest number previously paid for, the total number of claims and the number of independent claims have not increased. No petition for an extension of the response period is being made. Accordingly, Applicant believes no additional fees are due for the filing of this response. If any fees are due and/or any overpayments have been made, however, please charge and/or credit our deposit account (Deposit Account No. 03-1130).

SUMMARY AND CONCLUSION

In view of the fact that none of the art of the record, whether considered alone or in combination discloses, anticipates or suggests the present embodiments, as now defined by the independent claims, and in further view of the above amendments and/or remarks, reconsideration of the Action and allowance of the present patent application are respectfully requested and are believed to be appropriate.

Respectfully submitted,

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